

**REMARKS**

The Office Action mailed October 1, 2002 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-22 were pending in the application. Claims 1, 4, 20 have been amended, claim 2 has been canceled and claim 23 has been newly added. Therefore, claims 1 and 3-23 are pending and are submitted for reconsideration by the examiner.

FIG. 1 has been amended to correct a typographical error as shown in red on the drawings attached to the Proposed Changes to the Drawings being filed concurrently herewith.

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended claim 4 to address the issue noted in the Office Action and submit that claim 4 is now in definite form and meet the requirement of § 112, second paragraph.

In the Office Action, claims 1-5, 9-12, 14, 15, 18, 20, and 21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 5,901,224 to Hecht (hereafter "Hecht"). Claims 6-8, 16, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht, further in view of U.S. patent 5,444,479 to Daniele (hereafter "Daniele"). Applicants respectfully traverse these rejections, insofar as they may be applied to the pending claims, for at least the following reasons.

Independent claims 1 and 20 recite, *inter alia*, a system and method of processing an electronic document that includes a mark placed on a hardcopy of the document such that that the mark contains identification information of the electronic document. An image capture device is activated by waving a copy of the document so that an image of the hardcopy document may be captured and the mark may be decoded so that the electronic document may be processed in accordance with information that is encoded in the mark. See page 5, lines 20-29 of the specification. This recited feature is not disclosed by any of the applied references. Accordingly, the pending claims are believed to be patentable over the applied references.

This recited feature provides the benefit that the embedded mark may be rapidly read by an image capture device that is easily activated so that a copying or

other processing function is performed rapidly without unnecessary delay caused by the decoding of the embedded mark on the hardcopy of the document.

New claim 23 recites, *inter alia*, receiving a voice input indicative of an annotation or processing instruction for the document and placing a mark on the hardcopy, the mark containing identification information of the electronic document and the annotation or processing instruction for the document received from the voice input. This provides for a more efficient and flexible way of annotating a hardcopy so that its electronic document may be processed in accordance with the annotation for further actions or improved workflow. See, for example, page 11, lines 9-12 of the specification. This recited feature is also not disclosed or suggested by the applied prior art and claim 23 is believed to be patentable over the cited prior art.


The dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

In view of the foregoing amendments and remarks, applicants believe that the application is in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local number below.

Respectfully submitted,

December 31, 2002

Date



William T. Ellis

Registration No. 26,874

Aaron C. Chatterjee

Registration No. 41,398

Attached: Attachment A

**ATTACHMENT A**

**Marked up version of claim amendments made in the Amendment filed**

**January 2, 2002:**

1. (Amended) A method of processing an electronic document corresponding to a hardcopy of the document, comprising the steps of:

placing a mark on the hardcopy, the mark containing identification information of the electronic document;

viewing the hardcopy by an image capture device to capture an image of the hardcopy document, wherein the image capture device is activated by waving a copy of the hardcopy document in front of the image capture device;

decoding the mark from the image captured by the image capture device to determine identification information of the electronic document; and

processing the electronic document according to the identification information.

4. (Amended) The method according to claim 1, wherein the step of placing a mark is performed by a printer that prints [the] a digital mark on the hardcopy document.

20. (Amended) A system for processing an electronic document corresponding to a hardcopy of the electronic document, the system comprising:

a data storage device that stores the electronic document;

a mark encoder that encodes a mark on the hardcopy;

an image capture device that captures an image of the hardcopy including the mark, wherein the image capture device is configured to be activated by waving the hardcopy in front of the image capture device;

a decoder, operatively connected to the image capture device, for decoding document identification information from the mark from the image captured by the image capture device; and

a processing unit, connected to the decoder and the data storage device, that processes the electronic document in accordance with the decoded document identification information.

1/2

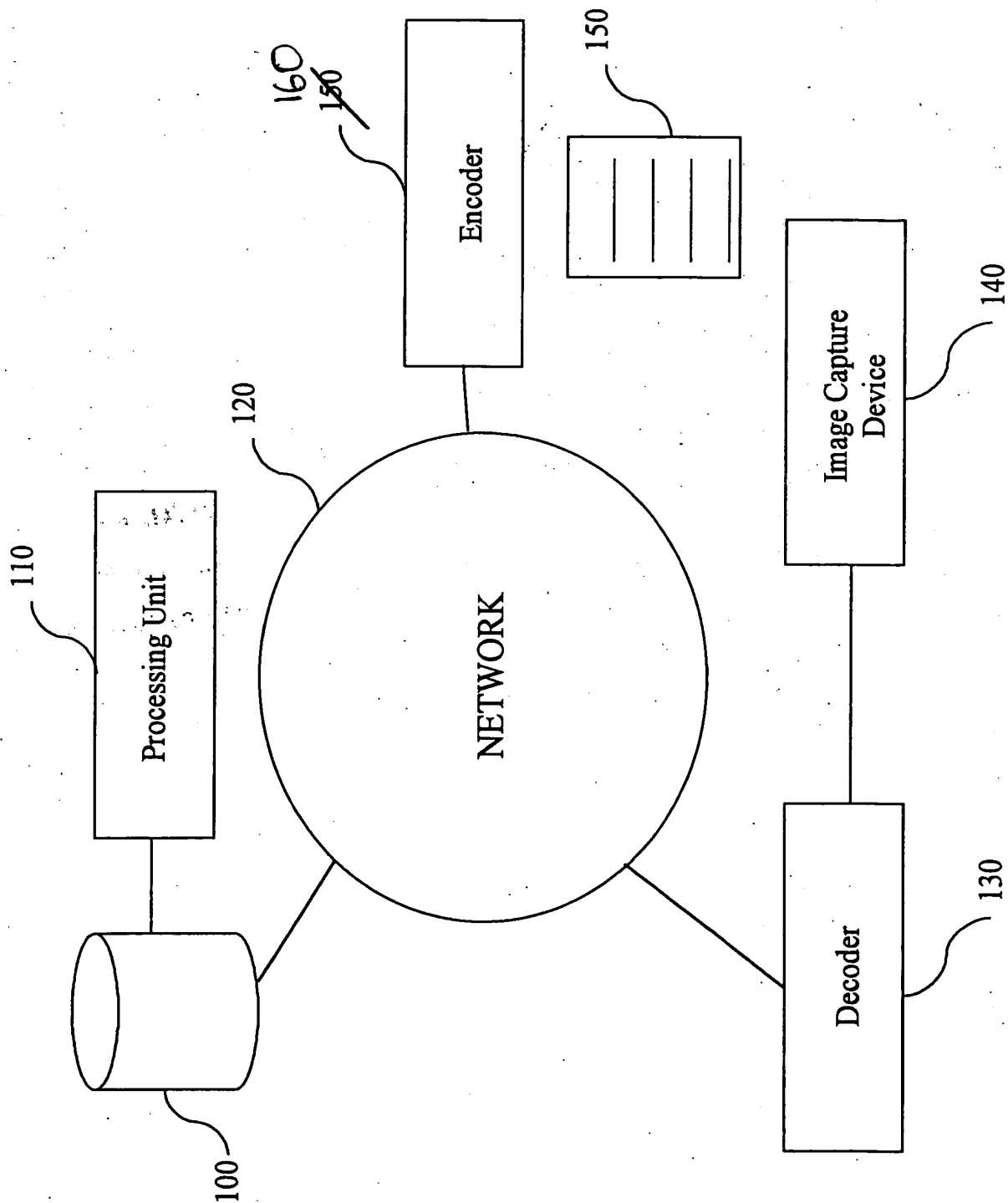


Fig. 1